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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,104	09/08/2003	Jonathan Ilan Leci		9756

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EXAMINER

ISSING, GREGORY C

ART UNIT PAPER NUMBER

3662

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,104

Applicant(s)

LECI, JONATHAN ILAN

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. This Office Action is responsive to the amendment filed 10/18/04.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 contains subject matter that is considered new matter; the capsule being "digestive" is not supported by the specification as originally filed and must be cancelled from the claim. In claim 14, the language "inflation of a life jacket" does not find support in the specification as originally filed and therefore is considered new matter.

4. Claims 8-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 8-14 are insufficiently disclosed in the specification. Applicant has not shown in the drawings nor described in the specification how one of ordinary skill in the art could make and/or use the subject matter wherein the sensor is activated by contact with any of "the alkaline", "the acid", "the saliva", or "the blood", or by contact "with water", by "air pressure" or "inflation".

5. Claim 12-14 are non-enabling. The sensor is a part of the swallowed capsule. The specification is insufficiently disclosed as to how the internally located capsule's sensor is activated by the inflation of an item, which applicant now defines as a "life jacket", that is not, or cannot be a

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part of the swallowable capsule. This is also true for the water contact or sensing of air pressure.

It is noted that the limitation of claim 12 "activated by contact with water" is interpreted in scope to the activation of the capsule when aided by drinking water or swallowed water as in drowning since likewise the detection of external water could not be sensed by the body internal capsule.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4-6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The transmitter being a "Global Positioning System transmitter" is indefinite. A GPS transmitter is a satellite, how this could fit into a swallowable capsule is not clear. This is likewise true for the language "a GALILEO satellite navigation system transmitter" and "satellite transmitter" each of which is directed to a satellite. It would appear that the capsule would require a receiver receptive to the transmitter systems in order to determine location and not the use of a GPS/GALILEO/satellite transmitter incorporated in the device since such use provides no location information per se unless there is some external system using conventional radio location techniques to locate a radio source, which is not disclosed in the instant application.

9. Claim 6 is not clear since it is not clear if this refers to the transmission of the distress signal from inside the body via a communication satellite or if it relates to determination of position using a satellite transmitter external thereto.

10. In claim 8, the language "the alkaline" is indefinite since it lacks a proper antecedent basis and since "alkaline" is an adjective, it is not clear what is being defined by "the alkaline in the human body."

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11. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sensor as well as the interconnection of elements must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the

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treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4, 6, 7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Guice et al.

14. Guice et al (2002/0010390) disclose a swallowable capsule housing a telesensor [0129]-[0130] which includes a power supply and transmitter as well as RF receiver circuitry and sensors such that the sensors may be used to activate a transmitter for monitoring the location of the animal, which generally defines a human, who swallowed the capsule. Sensors may include blood sensors. Radiolocation is described, and in particular GPS.

15. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark.

16. Clark (2003/0151524) discloses a locator device implanted in a human, possibly intraorally, for monitoring the location in the event of an emergency or abduction including a battery, and transceiver, see Figure 4 as well as [0016], [0020]. Additionally, a satellite navigation receiver for positioning is disclosed.

17. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Edelstein et al.

18. Edelstein et al (2004/0174258) disclose a tracking device that may be swallowed in a panic mode of operation [0045] and may include a satellite positioning receiver for determining position so that upon activation the position may be transmitted to the proper authorities. The device includes a power source, antenna, receiver and transmitter, see Figure 2 and Figure 8.

19. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Iddan.

20. Iddan (2003/0195415) discloses a swallowable capsule housing a power supply and transmitter for transmitting a location signal from inside a human body for monitoring the GI tract thereof.

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21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guice et al.

23. GALILEO is the European equivalent to the United States' GPS, each of which is a satellite navigation system, and, therefore, would have been within the skill of the artisan based on the country of origin. Since the sensors include biological and chemical sensors to monitor the animal's health, the monitoring of bodily fluids, including the alkalinity or acidity thereof, is deemed to be obvious to the skilled artisan to fully monitor the health of the animal.

24. Claims 5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark.

25. GALILEO is the European equivalent to the United States' GPS, each of which is a satellite navigation system, and therefore would have been within the skill of the artisan. In view of the use of the tracking device for emergency situations, the detection of man overboard or drowning conditions would have been an obvious use of the tracking device of Clark.

26. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein et al.

27. GALILEO is the European equivalent to the United States' GPS, each of which is a satellite navigation system, and therefore would have been within the skill of the artisan.

28. Applicant fails to persuasively show why the claim language distinguishes over the prior art. However, in light of the new rejections under 35 USC 112 and the new prior art references which show the claimed subject matter more clearly with respect to the intended use, a non-final Office Action is being mailed.

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29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

30. Man (4,706,689) discloses an implantable device including a power supply and transmitter that emits a distress signal in the range of the cellular telephone and/or satellite communication system as well as a sensor for monitoring physiological parameters that are physical and/or chemical for activating the distress signal. Man discloses "implantable . . . under the skin" or "partially under the skin" but does not teach being "swallowable."

31. Meyers et al (22020100425) disclose an implantable pellet that can be used for tracking human location and movement [0026] including a GPS receiver and a transmitter for transmitting desired information as well as sensors of physiological activities. The implantable pellet is described as being "implanted subdermally" or "beneath the hide or skin" but does not describe being "swallowed".

32. Gehlot et al (2003/0137419) discloses an implantable microchip singly housing a power supply 20, a GPS unit 12, a wireless communications 14, a memory 17 and sensors 16. The sensors may include an atmospheric pressure sensor [0028]. Gehlot et al disclose that the single integrated device may be "implanted beneath the skin of the monitored person" but do not teach being swallowable.

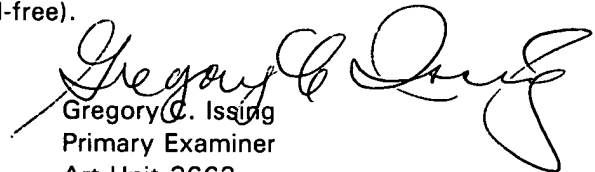
33. Glen (6,239,705) discloses an intra-oral tracking device (Figure 7) including a power source, receiver, passive to active actuator and transmitter. Additionally, Glen discloses that to charge the power supply known galvanic principles may be used such that the saliva may be used as an electrical conductor to collect and store electric charge for use in the power supply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is 703-306-4156. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci